

REMARKS/ARGUMENTS

Claims 22-24, 26-35, 37-44 and 47-51 are pending in this application. Declarations of the Applicants, Geoffrey Fonseca and Donald Frey, pursuant to 37 C.F.R. § 1.132 are attached at Appendix A.

The Office Action rejects claims 22-24, 26-29, 34, 35, 37-40 and 47-51 under 35 U.S.C. §103(a) as being unpatentable over Gueret. The Office Action concedes that the Gueret applicator bristles are not made from a polymeric material selected from the group consisting of: polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof, as in claims 22 and 34. But the Office Action contends it would have been obvious to modify the Gueret bristles to be made from this group of polymeric materials based upon the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use.

Gueret describes that its bristles can be made from vegetable, animal or natural fiber. (col. 8, lines 41-46). The Office Action relies upon In re Leshin, 125 USPQ 416 (CCPA 1960) for its determination of obviousness.

However, the decision In re Leshin, and the caselaw consistent with the Leshin decision, (see also Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327 (1945)), requires that there is knowledge of the suitability of the known material for the intended purpose. The Leshin Court concluded that it would have been obvious to select a known plastic "to make [the patentee's] container-dispenser of a type made of

plastics prior to the invention, the selection of the plastics being on the basis of suitability for the intended use." In re Leshin at 417-418.

In contrast, the applicants of the present invention, who have a combined forty-four years of experience in the research and development of bristles and the like, attest that there was no such knowledge of the suitability of this particular group of polymeric material for use in making bristles prior to their invention:

"Prior to our invention, the biodegradable, naturally based polymeric materials of polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives were unknown materials for use in cosmetic brushes for the application of cosmetics. The suitability of these materials for use in applying the cosmetic composition was unknown prior to our discovery." (Affidavit of Fonseca, par. 7); (Affidavit of Frey, par. 7).

Applicants use of the polymeric materials of polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof, for applying a material or cosmetic composition to a human, is not a mere selection based upon knowledge of the suitability of these materials for the intended purpose of applying a material or cosmetic composition to a human. This is not merely a design choice because this was an unknown material for use in cosmetic brushes for the application of cosmetics. The suitability of these materials for use in applying the cosmetic composition was unknown prior to Applicants' discovery.

Moreover, the applicants attest to the superiority of the polymeric group of materials for particular bristle properties:

"We have discovered that the bristles made of the biodegradable, naturally based polymeric materials of polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives have attributes of increased slip, increased wicking, the ability to make thin fibers, silky feel, excellent UV stability, oil and grease resistance, and good durability including superior twist retention, resilience, and elastic recovery. All of these attributes are important properties for bristles used in the manufacture of brushes for the application of a cosmetic composition. We have discovered that these polymeric materials are suitable for manufacture into the myriad of brush shapes, examples of which are depicted in Figs. 1 through 7 in the Application." (Affidavit of Fonseca, par. 8); (Affidavit of Frey, par. 8).

Claims 23-24, 26-29, 35, 37-40 and 47-51 depend from claim 22 or 34. Thus, these claims are also not obvious over Gueret.

The Office Action rejects claims 22-24, 26-29, 31-35, 37-40, 42-44 and 47-51 under 35 U.S.C. §103(a) as being unpatentable over Castells Ribas. The Office Action contends it would have been obvious to modify the Castells Ribas applicator bristles by making them from a polymeric material selected from the group consisting of: polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof, as in claims 22 and 34, based upon selecting a known material on the basis of its suitability for the intended use.

Castells Ribas describes bristles that can be made from vegetable fiber, which is preferably cotton, linen or the like. (col. 2, lines 13-15). As described above and attested to in the attached Declarations of Fonseca and Frey, Applicants have utilized particular polymeric materials recited in claims 22 and 34, whose use was unknown in cosmetic brushes for the application of cosmetics and which have increased bristle properties. Castells Ribas describes the use of cotton or linen fibers without any suggestion of the particular materials set forth in claims 22 and 34. The suitability of these materials for use in applying the cosmetic composition was unknown prior to Applicants' discovery.

Claims 23-24, 26-29, 31-33, 35, 37-40, 42-44 and 47-51 depend from claim 22 or 34. Thus, these claims are also not obvious over Castells Ribas.

The Office Action rejects claims 22, 24, 26-28, 30, 34, 37-39, 41, 47, 49 and 50 under 35 U.S.C. §103(a) as being unpatentable over Morganroth. The Office Action contends it would have been obvious to modify the Morganroth applicator bristles by making them from a polymeric material selected from the group consisting of: polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof, as in claims 22 and 34, based upon selecting a known material on the basis of its suitability for the intended use.

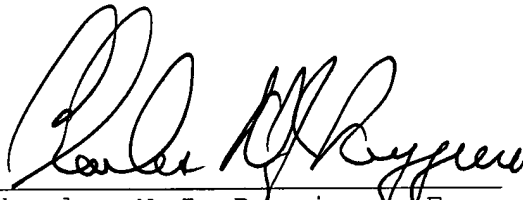
Morganroth describes bristles that can be made from vegetable fibers and animal hair such as pig hair and horse hair. (col. 40, lines 57-63). As described above and attested to in the attached Declarations of Fonseca and Frey, Applicants

have utilized particular polymeric materials recited in claims 22 and 34, whose use was unknown in cosmetic brushes for the application of cosmetics and which have increased bristle properties. Morganroth describes the use of vegetable fibers and animal hair without any suggestion of the particular materials set forth in claims 22 and 34. The suitability of these materials for use in applying the cosmetic composition was unknown prior to Applicants' discovery.

Claims 24, 26-28, 30, 37-39, 41, 47, 49 and 50 depend from claim 22 or 34. Thus, these claims are also not obvious over Morganroth.

In view of the foregoing, applicants respectfully submit that all claims present in this application patentably distinguish over the cited prior art. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejections of the claims. Also, applicants respectfully request that this application be passed to allowance.

Dated: December 16, 2007

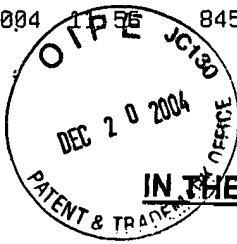


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Serial No.: 10/090,942

Art Unit: 3732

APPENDIX A



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Fonseca et al.
Serial No.: 10/090,942
Filed: March 5, 2002
For: APPLICATOR BRUSHES AND METHOD FOR USING SAME
Examiner: Robert, Eduardo C.
Art Unit: 3732
Customer Number: 27623
Confirmation No.: 6887

Attorney Docket No.: 679.0029USX

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. §1.132

Dear Sir:

I, Geoffrey Fonseca, applicant in the above-identified patent application, declare as follows:

1. I am a citizen of the United States of America, and a resident of 8 Beech Road, Suffern, New York 10901.
2. I hold a Master of Science degree in Chemical Engineering from the University of Rhode Island and Bachelor of Science in Chemical Engineering from the Indian Institute of Technology, Bombay.

Serial No. 10/090,942

Art Unit 3732

3. I am a Senior Manager in Research & Development with Avon, Inc. and have been with Avon since 1982. I have been in the cosmetics industry, including the research, development and manufacture of bristles and the like, since 1982.
4. I am one of the inventors of U.S. Patent Application Serial Number 10/090,942.
5. I have reviewed the Office Action of September 17, 2004 and U.S. Patent Nos. 6,073,634; 6,314,967 and 4,209,027.
6. The above-referenced patents provide for packaging and applicators for cosmetics. These patents note that cotton, linen, pig hair and horse hair may be used for the bristles of the applicators. However, these patents do not disclose or suggest the use of polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof, for applying a material or cosmetic composition to a human.
7. Prior to our invention, the biodegradable, naturally based polymeric materials of polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives were unknown materials for use in cosmetic brushes for the application of cosmetics. The suitability of these materials for use in applying the cosmetic composition was unknown prior to our discovery.
8. We have discovered that the bristles made of the biodegradable, naturally based polymeric materials of polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives have attributes of increased slip, increased wicking, the ability to make thin fibers, silky feel, excellent UV stability, oil and grease resistance, and good durability including superior twist retention, resilience, and elastic recovery. All of these attributes are important properties for bristles used in the manufacture of brushes for the application of a cosmetic composition. We have discovered that these polymeric materials are suitable for

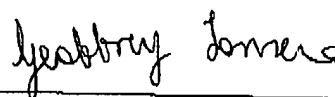
Serial No. 10/090,942

Art Unit 3732

manufacture into the myriad of brush shapes, examples of which are depicted in Figs. 1 through 7 in the Application.

9. I further declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

Declared at SUFFERN, U.S.A. this 29 day of NOV., 2004.



Geoffrey Fonseca

Don Frey - Avon

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P. 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Fonseca et al.
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Filed: March 5, 2002
For: APPLICATOR BRUSHES AND METHOD FOR USING SAME
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P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. §1.132

Dear Sir:

I, Donald H. Frey, applicant in the above-identified patent application, declare as follows:

1. I am a citizen of the United States of America, and a resident of 827 Huntley Drive, West Hollywood, CA 90069.
2. I hold a Bachelor of Science degree from Rice University in Chemical Engineering.

Serial No. 10/090,942

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3. I am a Vice President with Avon, Inc. and have been with Avon since January 1999. I have been in the cosmetics industry, including the research, development and manufacture of bristles and the like, since June, 1982.
4. I am one of the inventors of U.S. Patent Application Serial Number 10/090,942.
5. I have reviewed the Office Action of September 17, 2004 and U.S. Patent Nos. 6,073,634; 6,314,967 and 4,209,027.
6. The above-referenced patents provide for packaging and applicators for cosmetics. These patents note that cotton, linen, pig hair and horse hair may be used for the bristles of the applicators. However, these patents do not disclose or suggest the use of polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives, and any combinations thereof, for applying a material or cosmetic composition to a human.
7. Prior to our invention, the biodegradable, naturally based polymeric materials of polylactide, polycaprolactone, polyhydroxybutyrate/valerate, polyglycolic acid, polymer based on starch or starch derivatives were unknown materials for use in cosmetic brushes for the application of cosmetics. The suitability of these materials for use in applying the cosmetic composition was unknown prior to our discovery.
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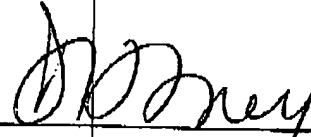
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Art Unit 3732

manufacture into the myriad of brush shapes, examples of which are depicted in Figs. 1 through 7 in the Application.

9. I further declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

Declared at West Hollywood, CA, U.S.A. this 19th day of November, 2004.



Donald H. Frey

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